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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,109	11/21/2001	Randall A. Boudouris	M112.2-10064	2833

490 7590 04/28/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/990,109

Applicant(s)

BOUDOURIS ET AL.

Examiner

Gladys J Piazza Corcoran

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-17,19-41,60 and 71-76.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Gladys J. Corcoran
Examiner
Art Unit: 1733

Continuation of 10. Other:

If filed in a separate amendment, the changes in the claims that address paragraphs 4, and 7 of the prior Office Action filed March 8, 2004 (canceling claim 71 and amending claim 75) would overcome those rejections.

It is noted that the status indicator of claim 75 should be (Currently Amended).

It is noted that Applicant's remarks refer to a copy of a web site that indicates both μ and μm are equivalent, however no such copy was found in the electronic file. Even though such symbols are considered equivalent, the Specification uses the symbol μ , therefore the amendments of changing the symbol μ to μm in the claims raises the new issue of the claims to lacking antecedent basis in the Specification.

The proposed Amendment to claim 1 of adding "hot melt" raises new issues such as creating lack of antecedent basis in the dependent claims; deleting the requirement of the particular thermoplastic polymers also raises new issues that would require further search and/or consideration. The proposed Amendment of deleting certain polymers in claim 60 also raises new issues that require further consideration. The addition of new claims with new combinations of new limitations also raise new issues that require further search and/or consideration.

All the rejections of the claims as set forth in the prior Office Action filed March 8, 2004 are maintained.

As a result of the current Amendment not being entered, only the arguments pertaining to the previously presented claims and rejections will be addressed.

Applicant argues on page 13 that the reference Sawa does not describe applying the magnet compositions to any sort of a substrate, that the compositions are injection molded and are not concerned with adhesion to a web or other substrate. Silverschotz discloses applying a magnetic material to a substrate. Sawa is cited to show it would have been obvious to one of ordinary skill in the art to provide the magnetic composition with a greater percentage of magnetic material in order to provide a stronger magnetic product. It is noted that the percentages in Silverschotz are preferred and not required. It is further noted that Sawa is not only directed to injected molded products, but also to extruded compositions (where it is further noted that Silverschotz also discloses extruding the magnetic composition).

Applicant argues on page 14 that Silverchotz discloses hot melt binder systems as preferably 30-60% by weight polymer and that the systems taught by Silverschotz would not achieve adequate adhesion in polymer concentrations of as little as 4% by weight. Applicant further argues on page 14 that there would have been no motivation to combine the references and no reasonable expectation of success that the compositions in Sawa could be employed in the process of Silverschotz. It is noted that the claims do not require as little as 4% weight (this % appears to be the minimum that Sawa teaches). The percentage in Silverchotz is only a preferred percentage and not a required percentage. As previously discussed, one of ordinary skill in the art would be motivated to provide a greater percentage of magnetic material in the composition in order to provide a stronger magnet as shown by Sawa.

Applicant's argues on page 14 that Sawa was issued prior to Silverschotz by 20 years and that Silverchotz would not have limited the polymer range. Applicant also argues on page 16 that if such polymers had been so conventional and obvious that Silverschotz would have included such polymers in their list. These arguments do not have merit. The failure of an Inventor to disclose or appreciate a smaller percentage of the polymer or a listing of conventional thermoplastics for hot melt polymers does not indicate that such a percentage or such types of polymers are not obvious.

Applicant argues on page 15 that claim 75 is directed to forming a pad article where magnetic sheet assemblies are layered to form a pad and that neither Silverschotz nor Sawa suggest such a magnetic assembly. As discussed in the prior Office actions, it is well known in the packaging arts to stack consumer articles into pads. Applicant did not timely traverse such a well known statement, therefore the statements are considered admitted prior art (see next paragraph).

Applicant argues on pages 18, 20, 21 that the well known statements relied upon for rejecting claims 11, 12, 19, 20, 22, 24, 75 and 76 are not provided with prior art and that Applicant now insists on prior art citations for these well known statements. Applicant's traversals are untimely at this late stage in the prosecution. The well known statements were applied in the Office Action filed October 3, 2003 and Applicant did not traverse the statements in the first response filed December 11, 2003. Consequently, Applicant has acquiesced to the statements as indicated in the Office Action filed March 8, 2003 and such statements are now considered admitted prior art (see MPEP 2144.03- "Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required.").

Applicant argues on page 19 that Silverchotz nor Sawa suggest a temperature of application for a hot melt binder system of the invention. Silverschotz discloses applying a hot melt to a substrate. The particular temperature that the hot melt is applied is considered well within the purview of one of ordinary skill in the art to select and is only dependent upon the hot melt polymer composition, the substrate selected, the speed of the application, etc. Only the expected results would be attained by selecting the temperature range as claimed.

Applicant argues on page 23 that there would be no motivation to look to the manufacture of magnetic markers for modifications in the process of Silverschotz which is for making web-based and sheet based goods. One of ordinary skill in the art performing the method of Silverschotz would look to well known practices for magnetizing the magnetic layer. Rippingale is merely an example of that well known practice.

Applicant argues on pages 24-25 that Martin does not disclose providing the magnetic layer directly onto the substrate layer. Silverschotz discloses applying the magnetic composition directly to the substrate layer. Martin discloses an example of providing a magnetic assembly with the magnetic layer being the same width and length as the substrate layer. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic layer in Silverchotz of the same width and length as the substrate in order to form the assemblies as shown in Martin, only the expected results would be attained.

Applicant argues on page 26 that Schramer makes no suggestion to combine removable labels with a magnetic layer. Silverschotz discloses a method of forming magnetic assemblies for advertising, marketing, etc. It is well known in such commercial arts to provide advertising materials with a release layer that is adhered to an article with adhesive. Schramer is an example of providing release liners adhered to marketing assemblies and articles. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the assemblies as formed by Silverschotz with the well known marketing techniques as shown by Schramer, only the expected results would be attained.

Applicant finally argues on pages 27-28 that Martin and Fosbenner do not disclose perforated over laminates for easy removal of the magnetic assembly and Mack does not suggest employing multi-layered labels with a magnetic layer. As discussed in the prior Office Actions, Silverschotz discloses providing an over laminate to the printed substrates and Martin, Fosbenner, and/or Mack are cited to show it is known to provide perforations in over laminates in order to allow the over laminate to provide protection to the underlying member until a consumer tears the over laminate to use the underlying member. Only the expected results would be attained.